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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,455	10/16/2003	David Rabe	10336/2	8737
27614	7590	08/04/2005	EXAMINER	
MCCARTER & ENGLISH, LLP FOUR GATEWAY CENTER 100 MULBERRY STREET NEWARK, NJ 07102			WIEKER, AMANDA FLYNN	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/687,455	<b>Applicant(s)</b> RABE, DAVID	
	<b>Examiner</b> Amanda F. Wieker	<b>Art Unit</b> 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/2/04; 9/9/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I in the reply filed on 08 July 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Applicant has cancelled non-elected claims 27-31. Claims 1-26 remain pending in this application.

### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rigid support member being located between the inner and outer layers (as described in the specification and claims) must be shown or the feature(s) canceled from the claim(s). The drawings appear to show rigid member (30) being located outside of outer layer (26). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the

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filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6-7, 9, 12-15, 17-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 4,862,900 to Hefe.

Regarding claims 1-4, 6-7 and 9, Hefe discloses an ankle brace comprising: a rigid member (40) sized to fit under a foot and extend up along an ankle and leg of an individual (see Figure 1); inner (36) and outer (38) layers surrounding the rigid member and forming a body having a foot portion with a forward edge defining a toe aperture (22), and a foot bed (14), and a leg portion with an upper edge (20), and rear edges (26, 32) extending from the upper edge (20) to the foot bed (14); and a fastening strap (34) connectable about the body to retain the brace on the foot, ankle and leg of an individual. The footbed is sized to extend from the ball of the foot to the heel portion of a foot (see Figure 1). The ankle brace further comprises a flexible heel portion (30; see crosshatching in Figure 2 and column 3, lines 44-60), wherein the flexible heel portion comprises inner (36) and outer (38) layers and a cushion layer therebetween (see column 3, lines 61-64; cushion at inside surface of inner layer). The ankle brace further

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comprises a leg cover (24) attached adjacent to a rear edge of the body for protecting the leg from the fastening strap (34). The ankle brace further comprises a cushion layer between the inner layer and the rigid member (see column 3, lines 61-64; cushion at inside surface of inner layer). The fastening strap (34) is secured with a hook-and-loop (VELCRO®) fastening system.

Regarding claims 12-15 and 17-19, Hefele discloses an ankle brace comprising: a foot engaging portion for receiving a foot in the form of a foot cover including a footbed (14), a forward edge (22), and a flexible heel (30); a leg engaging portion extending from the foot engaging portion, the leg engaging portion in the form of a leg cover including a top edge (20) and rear edges (26, 32) extending from the top edge towards the footbed (14) defining an opening; a rigid support member (40) in the footbed and extending from proximate the forward edge to the flexible heel, the rigid member further extending up the leg engaging portion; and means for retaining (34) the rear edges of the leg engaging portion in proximity to secure the ankle brace about the foot, ankle and lower leg of an individual. The foot engaging portion and the leg engaging portion comprise a soft durable material (multiply perlon fabric 36, 38) that encases the rigid member (40). The soft durable material comprises an inner layer (36) which lines the interior surface of the foot engaging portion and the leg engaging portion, and an outer layer (38) which covers the exterior surface of the foot engaging portion and the leg engaging portion. The ankle brace further comprises a cushion layer between the inner layer and the rigid member (see column 3, lines 61-64; cushion at inside surface of inner layer). The flexible heel portion comprises inner (36) and outer (38) layers of soft durable material, and a cushion layer therebetween (see column 3, lines 61-64; cushion at inside surface of inner layer). The means for retaining the rear edges in proximity comprises an adjustable strap including a hook-and-loop (VELCRO®) fastening system.

Regarding claims 20-23 and 25, Hefele discloses an ankle brace comprising: inner (36) and outer (38) layers forming a boot-shaped body having an open toe (22), an open back (32, 26) and a flexible heel (30); and a U-shaped support member (40) positioned between the inner and outer layers which extends along the bottom of a foot from the ball of the foot to the front of the flexible heel and up the sides of the boot-shaped body to support the inner and outer surfaces of the ankle and lower leg of an individual (see Figure 1). The ankle brace further comprises a means for securing (34) the brace to the leg. The means for securing the brace to the leg comprises an adjustable strap (VELCRO®). The ankle brace further comprises a cushion layer between the inner layer and the support member (see column 3, lines 61-64; cushion at inside surface of inner layer). The brace comprises a flexible heel portion (30) having inner (36) and outer (38) layers, and a cushion layer therebetween (see column 3, lines 61-64; cushion at inside surface of inner layer).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5, 7-8, 10, 15-17 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hefele in view of U.S. Patent Application Number 6,155,997 to Castro.

Hefele disclose the previously described ankle brace comprising an inner layer, an outer layer, and a rigid support member sized to fit between the inner and outer layers. Hefele further discloses the presence of a cushion layer on the inner surface of the inner layer. Hefele does not

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specify that the cushion layer comprise foam, or that the inner and outer layers comprise leather.

Castro discloses a multi-layer ankle brace comprising an inner layer (152), an outer layer (166), and a rigid support member (160) sized to fit between the inner and outer layers. Castro further discloses the presence of a cushioning foam layer (158) on the inner surface of the inner layer, between the inner layer and the rigid member. Castro specifies that such materials provide sufficient patient comfort without loss of support (see column 3, lines 66-67). Castro also discloses a relatively flexible heel portion, wherein the heel portion includes the inner layer, outer layer and foam, but does not include the rigid support member (see Figure 5).

It would have been obvious to one skilled in the art at the time the invention was made to have provided the ankle brace disclosed by Hefele, wherein the cushion layer comprises foam, and the inner and outer layers comprise leather, as taught by Castro, to provide sufficient patient comfort without loss of support.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hefele in view of U.S. Patent Application Number 5,720,715 to Eriksson.

Hefele disclose the previously described ankle brace comprising an inner layer, an outer layer, and a rigid support member sized to fit between the inner and outer layers. Hefele does not specify that the rigid support member comprise plastic.

Eriksson discloses a multi-layer ankle brace comprising an inner layer (27), an outer layer (26), and a rigid support member (11) sized to fit between the inner and outer layers. Eriksson specifies that the rigid support member be a thermoplastic material to allow custom adjustment of the rigid member to the specific patient (see column 3, lines 52-56).

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It would have been obvious to one skilled in the art at the time the invention was made to have provided the ankle brace disclosed by Hefe, wherein the rigid support member comprises a plastic material, as taught by Eriksson, to allow custom adjustment of the rigid member to the specific patient.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
afw

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